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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,246	11/15/2000	Tetsushi Tanizaki	49657-875	8725

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MCDERMOTT WILL & EMERY  
600 13TH STREET, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER

CHAUDRY, MUJTABA M

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/712,246

Applicant(s)

TANIZAKI ET AL.

Examiner

Mujtaba K Chaudry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-20 is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Specification*

The corrected or substitute specification were received on June 25, 2003. The specification is accepted.

### *Response to Amendment*

Applicant's arguments/amendments with respect to amended claims 2, 3 and 19 and original claims 1, 4-18 and 20 filed June 25, 2003 have been fully considered but are not fully persuasive. As a result, claims 17-20 are in condition for allowance and claims 1-16 are rejected. The Examiner would like to point out that this action is made final (See MPEP 706.07a).

In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). For example, Applicants contend that the prior art of record, Lepejian, does not disclose nor suggest "a select circuit selectively applying to said memory cell array test data applied from the said test circuit and data applied from said input buffer according to whether in test operation or a normal operation... **the select circuit defined in claim 1 switches between a signal applied from the ATE external to the memory device and a signal from the BIST circuit with programmable ALPG in the device. The signal (from the ATE**

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or BIST circuit) applied to select the circuit is a command control signal to control the memory device or an addressing array, not the data written/read out with respect to the memory array.” The Examiner disagrees. Lepejian teaches, as admitted by the Applicants, a select circuit which increments or decrements the sequence of the address generated by an address generation circuit. This limitation can be interpreted as “...selectively applying...” since incrementing/decrementing is a selective process. The Examiner believes that the Applicants are basing their contentions based on the “bold” limitations (above) stated in their specification and not the claims. The claims language is interpreted in its broadest reasonable interpretation as decided in *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is perhaps suggested by the Examiner to explicitly define these limitations in the claim language.

### ***Claim Rejections - 35 USC § 103***

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lepejian et al (USPN 5974579). See paper No. 7.

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The Examiner disagrees with the Applicant and maintains rejections with respect to amended claims 2-3 and original claims 1 and 4-16. As a result, claims 17-19 are in condition for allowance. All arguments have been considered. It is the Examiner's conclusion that amended claims 2-3 and original claims 1 and 4-16, as stated, are not patentably distinct or non-obvious over the prior art of record.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

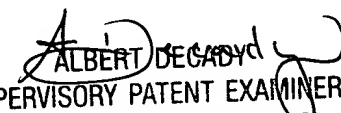
Any inquiries concerning this communication should be directed to the Examiner, Mujtaba Chaudry who may be reached at 703-305-7755. The Examiner may normally be reached Mon – Thur 7:30 am to 4:30 pm and every other Fri 8:00 am to 4:00 pm.

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If attempts to reach the Examiner by telephone are unsuccessful, please contact the Examiner's supervisor, Albert DeCady at 703-305-9595. The fax phone number for the organization where this application is assigned is 703-746-7239.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the receptionist at 703-305-3900.

  
Mujtaba Chaudry  
Art Unit 2133  
July 4, 2003

  
ALBERT DECADY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100